

REMARKS

Claims 1 to 8, 10 to 14, 17 and 18 are currently pending and being considered in the present application. (claims 15 and 16 were previously withdrawn in response to a restriction requirement).

Reconsideration is respectfully requested based on the following.

Claims 1 to 14 and 17 to 18 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, it is asserted that in the phrase “outputting useful data in a vehicle” is ambiguous as to whether the system or device is inside the vehicle or the data is inside the vehicle. The rejections are respectfully traversed.

The Final Office Action acknowledges that “in the specification, the storage medium for the data is, in fact, inside the vehicle.” (Final Office Action, paragraph 3). It is still asserted, however, that “the claims do not specify the said location of the storage medium for the data.” It is respectfully submitted that if upon review of a claim in its entirety, the Office concludes that a rejection under 35 U.S.C. 112, ¶ 2 is appropriate, an analysis as to why the phrase(s) used in the claim are “vague and indefinite” should be included in the Office action. *M.P.E.P.* § 2173.02. The Final Office Action has not included any such analysis.

Instead, the Final Office Action conclusorily asserts that “it is ambiguous as to whether the system or device is inside the vehicle or the data is inside the vehicle,” which is completely unrelated to whether the phrases or terms of the claim are vague and indefinite. In this regard, it is further noted that the claims recite the claimed subject matter. Their purpose is not to explain how the claimed subject matter works. That role is left to the specification. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983). It is respectfully submitted that claims 1 and 17 are clear and give rise to no ambiguity, and that they therefore satisfy the requirements of 112, ¶ 2.

Still further, the specification clearly describes how to practice the subject matter of claims 1 and 17. For instance, the specification provides several exemplary scenarios of the method and system which would make clear to one skilled in the art the meaning of the cited phrase. For example, it discloses that a CD (and thus digital data) in a vehicle may be played back once the digital right is transmitted. It is also provided that digital data may be broadcast to the vehicle (e.g. music) which may be played back once the digital right is transmitted. (See Specification, page 7, line 1 to page 8, line 16). Thus, one skilled in the art would understand every term and phrase of the claimed subject matter in light of the Specification.

It is therefore respectfully requested that the indefiniteness rejections of claims 1 and 17, and their respective dependent claims, be withdrawn.

Claim 1 to 4 and 17 to 18 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 7,212,989 (the “Taniguchi” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claim 1 is to a method for outputting *protected useful data in a vehicle* including granting a usage authorization of the data *in the vehicle* as a function of one of a road traveled and an area traveled, and checking in a rights analysis unit, which is coupled to a playback unit, whether a usage right exists to play back the useful data. The specification clearly

describes *useful data* that is to be made available *in the vehicle* where it can be played back if usage rights are authenticated. In this regard, the specification also discloses that in one refinement, “the useful data is transmitted via a radio *signal into the vehicle* ... in encrypted form.” (Specification, page 2 lines 22 to 24, (emphasis added)). The specification describes that in another embodiment that “the useful data is provided in the vehicle on a storage medium.” (Specification, page 2 lines 24 to 28, (emphasis added)).

Thus, information may be distributed “via generally accessible media such as radio, CD, DVD, etc., and only making them accessible to the actual users of a toll road and/or a highway, a highway type, or an area. Examples of such transmitted contents are radio programs, music, videos, maps, and route data for navigation systems, traffic, travel, hotel, or restaurant information, weather or stock exchange information, or internet data.” (Specification, page 4, lines 14 to 23). Thus, the *digitally protected* “useful information” is *provided to and in the vehicle*.

In stark contrast, the “Taniguchi” reference concerns the “transfer [of] information between the vehicle-mounted apparatus and the on-road apparatus, toll information or vehicle information about a vehicle, and information about a user”. (“Taniguchi” reference, column 1, lines 39 to 42.) In particular, it refers to “a person that is not intended by the user or the information provider can easily falsify the contents of the user information about a user such as the balance of charges, and the like, thereby resulting in deterioration of security.” (“Taniguchi” reference, column 2, lines 29 to 33.) Thus, it deals with security concerns of information emanating *from a vehicle to a roadside communication device*. (See “Taniguchi” reference, column 3, lines 30 to 54). Nowhere does it describe or even suggest the feature of “*outputting protected useful data in a vehicle*”, as provided for in the context of the claimed subject matter.

Further, the “Taniguchi” reference does not describe nor even suggest the claim feature of “checking in a rights analysis unit, which is coupled to a playback unit”, as provided for in the context of the claimed subject matter. In this regard, the specification provides that the playback unit may play the contents of the useful information in the vehicle. As provided in the discussion above, this may include media such as radio, CD, DVD, etc. Nothing in the “Taniguchi” reference describes “checking in a rights analysis unit, which is *coupled to a playback unit*” as provided in the context of the claimed subject matter.

Still further, the Taniguchi reference concerns a vehicle-mounted communication device and a road-to-vehicle communication device which allow communication of information using a simple structure by making leakage of information difficult. Information

including encryption information is communicated between an on-road apparatus having a memory in which an electronic key is stored, and a vehicle-mounted apparatus having a storage circuit. Encrypted route information is stored as is in the vehicle-mounted apparatus and encryption/decoding are executed at on on-road apparatus. Accordingly, the vehicle-mounted apparatus does not require encryption or decoding. (See Abstract). However, the lack of encryption/decoding in the vehicle means that encrypted information cannot be “output” (i.e., played back) on radio, CD, DVD or other media player inside the vehicle.

Therefore, Taniguchi, does not describe nor even suggest the feature of “checking in a rights analysis unit, which is coupled to a playback unit, whether a usage right exists for the useful data to be played back,” as in claims 1 and 17.

In particular, the “Taniguchi” reference refers to preparation of the toll information and transmission, together with an end signal, to the vehicle mounted apparatus in the form of a common sentence without being encrypted. (“Taniguchi” reference, col. 13, lines 55 – 60). The display unit (an LCD or CRT) for displaying various information does not perform any encryption or decryption of information, since it is merely sent to the display unencrypted. Moreover, Taniguchi specifically discourages processing and encryption or decoding functions for vehicle mounted apparatus. (“Taniguchi” reference, col. 12, lines 28 – 36). In so far as the Taniguchi system sends information unencrypted to a display unit, while discouraging encryption and decryption at the vehicle mounted apparatus, Taniguchi does not disclose a rights analysis unit, which is coupled to a playback unit, that checks whether a usage right exists to playback the useful data, as provided for in the context of the claimed subject matter.

It is therefore respectfully submitted that the “Taniguchi” reference does not describe or suggest the features of independent claim 1, so that claim 1 is allowable, as are its dependent claims.

Claim 17 includes features like those of claim 1, and is therefore allowable for essentially the same reasons, as are its dependent claims.

Accordingly, claims 1 to 8, 10 to 14, 17 and 18 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of pending and considered claims 1 to 8, 10 to 14, 17 and 18 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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